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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1933.0010008	
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	09/864,293	May 25, 2001	
	First Named Inventor	Michael E. AUFRICHT	
	Art Unit	Examiner	
	3622	Duran, Arthur D.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>28,458</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>One (1)</u> forms are submitted.</p>			

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1,042,074

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

AUFRICHT *et al.*

Appl. No.: 09/864,293

371(c) Date: May 25, 2001

For: **Interactive Advertisement Mechanism
on a Mobile Device**

Confirmation No.: 3536

Art Unit: 3622

Examiner: Duran, Arthur D.

Atty. Docket: 1933.0010008

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Amendment and Reply under 37 C.F.R. § 1.111 filed on May 12, 2009, in response to the Office Action issued on January 12, 2009, appear not to have been properly considered and were not properly responded to by the Examiner in the Final Office Action issued on May 20, 2009 ("Final Office Action"). Furthermore, Applicants' arguments in the Reply under 37 C.F.R. § 1.116 filed on July 20, 2009, in response to the Final Office Action, appear not to have been properly considered and were not properly responded to by the Examiner in the Advisory Action issued on July 31, 2009 ("Advisory Action").

The Examiner's responses in the Final Office Action and the Advisory Action were legally and factually deficient at least because the Examiner failed to show where the applied references teach or suggest "*generating tracking data representative of a browsing activity of the user while using the device...*" and "*storing the tracking data on the device,*" as recited in independent claim 1, and using respective language, claims 16, 46, 53, and 65.

Furthermore, the Examiner also failed to show where the applied references teach or suggest “*wherein the synchronization token is a value that is compared to values stored at the server to determine a state of data on the device,*” and “*receiving a second synchronization token from the server, wherein a value of the second synchronization token is larger than a value of the first synchronization token and wherein the second synchronization token is indicative of the content received from the server,*” as recited in claims 66 and 67, respectively.

Claims 1, 2, 4, 6, 7, 9, 16, 17, 19, 21, 22, 24, 59-64, 66, and 67 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,516,341 to Shaw et al. (“Shaw”) in view of U.S. Patent No. 5,848,396 to Gerace (“Gerace”). Claims 3, 5, 18, and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 5,794,210 to Goldhaber et al. (“Goldhaber”). Claim 50 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 6,332,127 to Bandera et al. (“Bandera”) in view of Goldhaber. Claims 23, 46-54, and 65 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over in view of Shaw in view of Gerace in view of Bandera. Claims 57 and 58 were rejected under 35 U.S.C. § as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 5,933,811 to Angles et al. (“Angles”).

Claim 1

In the Advisory Action, the Examiner alleged that “Gerace discloses tracking browsing activity and Shaw discloses storing relevant user data on the user device. Hence, the combination renders the features obvious.” Applicants disagree.

Neither of Gerace and Shaw teach or suggest a system that can record user history at the client device. Gerace describes recording a user history when the user logs onto program 31, which is running on a server. The user history is stored *where it is collected*, i.e., the server. See, e.g., Gerace, Col. 3, lines 61-67, Col. 4, lines 11-28, and Col. 6, lines 41-45. Shaw describes storing advertisement statistics, an event log, and other similar information, *where it is collected*, i.e., on the client device. See, e.g., FIGs 5 and 6, Col. 23, lines 25-32, and Col. 19, lines 15-35 of Shaw.

The Examiner appears to attempt to combine the user history recording of Gerace with the device-side information collection of Shaw to attempt to teach or suggest “storing the tracking data on the device,” as recited in claim 1. As described above, both Gerace and Shaw

describe storing information at the device at which it is collected. Thus, even assuming that Gerace's user history information teaches or suggest tracking data, as recited in claim 1 (to which Applicants do not acquiesce), the hypothetical combination of Shaw and Gerace that the Examiner puts forth would lead to a system that stores the alleged tracking data at the server, not the device. Therefore, Applicants assert that the alleged combination of Shaw and Gerace in fact teaches away from the storing tracking data *on the device*, as recited in claim 1.

Furthermore, modifying the disclosure of Gerace so that the hypothetical combination of Shaw and Gerace teaches or suggests storing the alleged tracking data on the device goes beyond the disclosures of both Shaw and Gerace and instead would rely on speculation and/or hindsight. Both the BPAI and Federal Circuit require the Examiner to show obviousness without relying on mere speculation or conjecture. (See *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the obviousness) (emphasis added).)

In particular, there is no description in either of Shaw or Gerace of a system that would be capable of recording user history information at the device. Gerace describes using program 31, running on the server, to record the user's activity. Gerace does not describe recording the user's activity at the device. Shaw describes storing information collected at the device. The information collected at the device, however, is limited to advertisement statistics, an event log, and other similar information. As Applicants noted in the Amendment and Reply filed May 12, 2009 and the Reply filed July 20, 2009, and to which the Examiner did not object in the Final Office Action and the Advisory Action, respectively, none of the information collected at the device as shown even suggests tracking data, as recited in claim 1. Moreover, there is no teaching or suggestion in Shaw that the mechanisms used to collect the device-side information could be used to collect tracking data.

Thus, both Shaw and Gerace describe systems that store data where it is collected and neither teach nor suggest collecting tracking data at the client device. Therefore, a hypothetical combination of Shaw and Gerace, even assuming the user history information described in Gerace teaches tracking data, as recited in claim 1, which Applicants do not concede, at most suggests storing tracking data at the server, not at the client device, as recited in claim 1. Accordingly, Shaw and Gerace cannot be used to establish a prima facie case of obviousness for claims 1, 16, 46, 53, and 65.

Claims 66 and 67

As Applicants separately argued in the Reply filed July 20, 2009, and to which the Examiner did not respond in the Advisory Action, claims 66 and 67, which depend from independent claim 1, recite features that further distinguish over Shaw and Gerace. For example, claim 66 recites “wherein the synchronization token is a value that is compared to values stored at the server to determine a state of data on the device,” and claim 67 recites “receiving a second synchronization token from the server, wherein a value of the second synchronization token is larger than a value of the first synchronization token and wherein the second synchronization token is indicative of the content received from the server.”

On page 18 of the Final Office Action, the Examiner alleged that Col. 6, lines 25-40 and Col. 7, lines 7-20 of Shaw teach or suggest the features of claim 66. The cited portions of Shaw describe advertisement statistics, such as which advertisements are shown to a user and client statistics, such as when a user activates the client program. Neither of the advertisements statistics and client statistics teaches a synchronization token, as recited in claim 66 at least because neither is a value or includes a value that is compared to stored values to determine a state of data on the device.

Also on page 18 of the Final Office Action, the Examiner alleged that Col. 19, lines 47-59, Col. 2, lines 35-42, Col. 5, lines 20-28, Col. 7, lines 20-28, Col. 13, lines 40-50, and Col. 16, line 65-Col. 17, line 5 of Shaw teach or suggest the features of claim 67. The cited portions of Shaw describe sending advertisements to receivers and having the receiver replace advertisements once the advertisements have expired. None of the cited portions of Shaw, however, teach or suggest a second synchronization token, as recited in claim 67, at least because none of the cited portions of Shaw teach or suggest a value that is indicative of content received from a server.

Accordingly, Shaw and Gerace cannot be used to establish a prima facie case of obviousness for claims 66 and 67.

Conclusion

Accordingly, the Examiner's continued rejection of claims 1, 16, 46, 53, and 65-67 under 35 U.S.C. § 103(a) based on Shaw and Gerace are legally and factually deficient. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Glenn J. Perry", with a long horizontal flourish extending to the right.

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Date: 20 Oct. 2009

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